Remarks/Arguments

The Official Action of April 8, 2005, has been considered. Reconsideration of this application, in view of the remarks below, is respectfully requested.

I. Status of the Claims and Specification

Claims 1-9 are pending. There are no claim amendments.

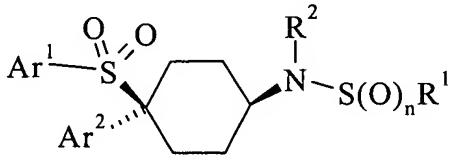
The abstract is amended.

II. Obviousness-Type Double Patenting Rejection

Claims 1, 2, 6 and 7 are provisionally rejected on obviousness-type double patenting grounds over claims 1-6 of co-pending, commonly owned application serial no. 10/679,902, published as US 20040121995 A1 (and now granted as U.S. Pat. No. 6,890,956). The Examiner states that the compounds claimed in claims 1-6 of the '956 patent are "a subgenus of the compound of general formula I and their compositions in the presently claimed invention." The Examiner states that the differences between the claimed compounds and the compounds claimed in the '956 patent "are not a patentable distinction because [the '956 patent] teaches the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the invention would be *prima facie* obvious to one of ordinary skill in the art."

Applicants respectfully traverse the double patenting rejection, on the grounds that the claims of the '956 patent are not "a subgenus" of the compounds claimed in this application. Rather, as explained below, there is no overlapping subject matter between the claims of this application and the claims of the '956 patent. As a result, the pending claims are patentably distinct from the claims of the '956 patent.

The claims of the '956 patent require a $-N(R^2)S(O)_nR^1$ group bonded directly to the cyclohexyl ring, as shown below:



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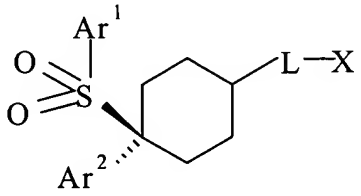
wherein R^1 is CF_3 or optionally substituted C_{1-6} alkyl, C_{2-6} alkenyl, C_{3-9} cycloalkyl or C_{3-6} cycloalkyl-C_{1-6} alkyl, or R^1 is aryl, aryl C_{1-6} alkyl, C-heterocyclyl or C-heterocyclyl-C_{1-6} alkyl; and R^2 is hydrogen or C_{1-4} alkyl. There is no suggestion in the claims of the '956 patent to expand this genus, by modifying the $-N(R^2)S(O)_nR^1$ substituent.

In contrast, the pending claims of this application have an -L-X group bonded to the cyclohexyl ring, as shown below:



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wherein L is a bond, an alkyl or an alkenyl group, as more particularly defined in the claims. The claims of the application exclude compounds covered by claims of the '956 patent. For example, pending claim 1 contains a proviso that states that "L does not represent a bond when X represents $NHCOR^1$, $NHCO_2R^1$ or $NHSO_2R^1$." The only other possible X groups recited in pending claim 1 which would have a nitrogen atom bonded directly to the cyclohexyl ring (when L is a bond) are -$NHCON(R^2)_2$ and -$NHSO_2N(R^2)_2$. However, these groups are not encompassed within the claims of the '956 patent. The '956 claims do not cover an -$NHCON(R^2)_2$ substituent on the cyclohexyl ring because the '956 claims do not permit the -NH-C(=O)- moiety that is present within the $NHCON(R^2)_2$ substituent. In addition, the '956 claims do not cover an -$NHSO_2N(R^2)_2$ substituent on the cyclohexyl ring because the '956 claims do not permit the -N-SO_2-N- moiety that is present within the $NHSO_2N(R^2)_2$ substituent.

Since there is no overlap between the claims of this application and the claims of the '956 patent, and since there is no suggestion in the '956 patent to expand the genus of compounds claimed therein, the pending claims are not obvious on double patenting grounds over the claims of the '956 patent.

In view of the arguments made, it is believed that the obviousness-type double patenting rejection has been overcome, and it is respectfully requested that the rejection be withdrawn.

III. Objections to Abstract

The abstract is objected to as lacking a description of the subject matter. In response, the abstract is amended to list representative substituents for the radicals Ar^1, Ar^2, L and X. In view of the action taken, it is believed that the objection is unwarranted and should be withdrawn.

IV. Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's statement at page 2 of the office action that claims 3-5 are allowable. The Examiner states that claims 3-5 stand objected to as dependent on a rejected base claim (claim 1), but would be allowable if written in independent form.

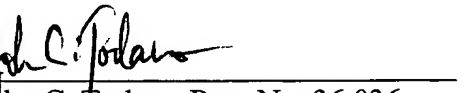
In response, the Examiner is directed to the arguments above in response to the double patenting rejection of base claim 1. In view of the arguments made, claim 1 is in condition for allowance. As a result, the objection to claims 3-5 is unwarranted and should be withdrawn.

V. Conclusion

In view of the action taken and arguments made, it is believed that claims 1, 2, 6 and 7 are not obvious on double patenting grounds over U.S. Patent No. 6,890,956. It is further believed that all pending claims 1-9 are now in condition for allowance.

Favorable action is earnestly solicited.

Respectfully submitted,

By 

John C. Todaro, Reg. No. 36,036
Attorney for Applicants

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065
Tel.: (732) 594-0125

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